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JEFFREY I. KAPLAN, ESQ., ET AL.			MOLINARI, MICHAEL J	
KAPLAN & GILMAN, LLP			ART UNIT	PAPER NUMBER
900 ROUTE 9 NORTH			2665	14
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/694,657	SPONAUGLE ET AL.
	Examiner Michael J Molinari	Art Unit 2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 November 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

1) Notice of References Cited (PTO-892)      4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.      6) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-14, 16-17, 19-30, and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Gudjonsson et al. (U.S. Patent No. 6,564,261).
3. Referring to claim 1, Gudjonsson et al. disclose a computer system comprising: a storage medium (GSM phone, see column 25, line 64. Could also be a PC, see column 25, line 21 or line 43) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for generating on behalf of an offeror client, an electronic token (invitation or INVITE, see column 9, lines 3-7) representing an offer to participate in a voice call (see column 3, lines 16-17) with a destination party designated by the offeror client (see column 27, line 62 through column 28, line 7), the electronic token to be transmitted by the offeror client in association with an electronic mail message (see column 12, lines 61-67, column 13, lines 1-11 and 28-39, and column 36, lines 32-34) to an offeree (see column 34, lines 13-16), services for receiving on behalf of the offeror client, through a data network link, a notification from the offeree denoting the offeree's acceptance of the offeror client's offer by activating said electronic token (see column 26, lines 7-17), and services for

causing a voice call to be initiated between the destination party designated by the offeror client and the offeree immediately (see column 26, lines 7-17) in response to the offeree's acceptance of the offeror client's offer (see column 26, lines 7-17); and an execution unit (PC)coupled to the storage medium for executing the plurality of programming instructions (GSM phone, see column 25, line 64. Could also be a PC, see column 25, line 21 or line 43).

4. Referring to claim 2, Gudjonsson et al. disclose that the offeree accepts the offeror client's offer by activating the electronic token displayed on the offeree's computer system (see column 26, lines 7-17).
5. Referring to claim 4, Gudjonsson et al. disclose that the electronic token comprises a graphical icon (Dialogue, see column 26, line 17, and note that dialog boxes are graphical icons).
6. Referring to claim 5, Gudjonsson et al. disclose that the electronic token comprises a URL (see column 25, lines 21-42).
7. Referring to claim 6, Gudjonsson et al. disclose that the voice call comprises at least one of a circuit switched call and a packet based call (see column 3, lines 14-17 and note that arbitrary networks could include circuit switched or packet based networks).
8. Referring to claim 7, Gudjonsson et al. disclose that the services for causing the voice call to be established between the destination party designated by the offeror client and the offeree, comprise services for causing a first voice call to be established with the offeree, services for causing a second voice call to be established with the designation party designated by the offeror client, and services for causing the first and second voice calls to be bridged to place the offeree and the destination party designated by the offeror client in voice communication with each other (see column 25, lines 21-42).

9. Referring to claim 8, Gudjonsson et al. disclose that the destination party designated by the offeror client is the offeror client (see column 25, lines 21-42).

10. Referring to claim 9, Gudjonsson et al. disclose that the first and second voice calls each comprise a circuit switched call (see column 26, lines 18-36).

11. Referring to claim 10, Gudjonsson et al. disclose that the first voice call comprises a circuit switched call and the second voice call comprises a packet based call (see column 25, lines 43-63).

12. Referring to claim 11, Gudjonsson et al. disclose that the first voice call comprises a packet based call and the second voice call comprises a circuit switched call (see column 25, line 64 to column 26, line 17).

13. Referring to claim 12, Gudjonsson et al. disclose that the first and second voice calls each comprise a packet based call (see column 25, lines 21-42).

14. Referring to claim 13, Gudjonsson et al. disclose that the electronic token is generated on behalf of the offeror client based at least in part upon data provided to the computer system by the offeror client, the data associated with at least one of a PSTN extension corresponding to the destination party designated by the offeror client and a PSTN extension corresponding to the offeree (see column 11, lines 44-64 and see column 25, line 21 to column 26, line 36).

15. Referring to claim 14, Gudjonsson et al. disclose that the PSTN extension corresponding to the offeror client is obscured to prevent the offeree from identifying the PSTN extension associated with the destination party designated by the offeror client (see column 10, lines 28-33).

16. Referring to claim 16, Gudjonsson et al. disclose a method comprising: transmitting by an offeror party in association with an electronic mail message (see column 34, lines 13-16 and see column 12, lines 61-67, column 13, lines 1-11 and 28-39, and column 36, lines 32-34), an electronic token (invitation or INVITE, see column 9, lines 3-7) representing an offer to participate in a voice call (see column 3, lines 16-17) with a destination party; receiving by an offeree party, the electronic token representing the offer to participate in the voice call with the destination party (see column 26, lines 2-17); receiving on behalf of the offeror client, through a data network link, a notification from the offeree denoting the offeree's acceptance of the offeror client's offer by activating said electronic token (see column 26, lines 7-17); and causing a voice call to be initiated between the destination party designated by the offeror client and the offeree immediately in response to the offeree's acceptance of the offeror client's offer (see column 26, lines 7-17).

17. Referring to claim 17, Gudjonsson et al. disclose that the offeree party accepts the offer to participate in the voice call by activating the electronic token representing the offer (see column 26, lines 7-17).

18. Referring to claim 19, Gudjonsson et al. disclose that the electronic token comprises a graphical icon (Dialogue, see column 26, line 17, and note that dialog boxes are graphical icons).

19. Referring to claim 20, Gudjonsson et al. disclose that the electronic token comprises a URL (see column 25, lines 21-42).

20. Referring to claim 21, Gudjonsson et al. disclose that the destination party is the offeror party (see column 25, lines 21-42).

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21. Referring to claim 22, Gudjonsson et al. disclose that the voice call comprises at least one of a circuit switched call and a packet based call (see column 3, lines 14-17 and note that arbitrary networks could include circuit switched or packet based networks).
22. Referring to claim 23, Gudjonsson et al. disclose that bridging the voice call further comprises: establishing a first PSTN call with the offeree; establishing a second PSTN call with the destination party; and bridging the first and the second PSTN calls (see column 26, lines 18-36).
23. Referring to claim 24, Gudjonsson et al. disclose that bridging the voice call further comprises: establishing a first PSTN call with the offeree; establishing a second VoIP call with the destination party; and bridging the first PSTN call and the second VoIP call (see column 25, lines 43-63, see column 2, lines 24-29, see column 38, lines 8-16, and see column 34, lines 50-55).
24. Referring to claim 25, Gudjonsson et al. disclose that bridging the voice call further comprises: establishing a first VoIP call with the offeree; establishing a second PSTN call with the destination party; and bridging the first VoIP call and the second PSTN call (see column 25, line 64 to column 26, line 17, see column 2, lines 24-29, see column 38, lines 8-16, and see column 34, lines 50-55).
25. Referring to claim 26, Gudjonsson et al. disclose that bridging the voice call further comprises: establishing a first VoIP call with the offeree; establishing a second VoIP call with the destination party; and bridging the first and the second VoIP calls (see column 25, lines 21-42, see column 2, lines 24-29, see column 38, lines 8-16, and see column 34, lines 50-55).

26. Referring to claim 27, Gudjonsson et al. disclose that the token is generated by a third party (Device Handler) based at least in part upon data provided to the third party by the offeror party in association with a contractual relationship previously established between the third party and the offeror party (see column 9, lines 41-61 and column 25, lines 43-63).

27. Referring to claim 28, Gudjonsson et al. disclose that the data provided to the third party by the offeror party includes a first PSTN extension corresponding to the offeree party and a second PSTN extension corresponding to the destination party (see column 11, lines 44-64 and see column 25, line 21 to column 26, line 36).

28. Referring to claim 29, Gudjonsson et al. disclose that the second PSTN extension is obscured to prevent the offeree party from identifying the second PSTN extension (see column 10, lines 28-33).

29. Referring to claim 30, Gudjonsson et al. disclose that the data provided to the third party includes billing information (see column 9, lines 41-61).

30. Referring to claim 32, Gudjonsson et al. disclose a computer system comprising: a storage medium (GSM phone, see column 25, line 64. Could also be a PC, see column 25, line 21 or line 43) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for receiving on behalf of an offeror client, through a data network link, a notification from an offeree denoting the offeree's acceptance of the offeror client's offer to participate in a voice call with a designated destination party (see column 26, lines 7-17), the offer communicated to the offeree by an electronic token in association with an electronic mail message (see column 34, lines 13-16 and see column 12, lines 61-67, column 13, lines 1-11 and 28-39, and column 36, lines 32-34), and for causing the voice

call to be initiated between the designated destination party and the offeree immediately in response to the offeree's acceptance of the offeror client's offer (see column 26, lines 7-17); and an execution unit (GSM phone, see column 25, line 64. Could also be a PC, see column 25, line 21 or line 43) coupled to the storage medium for executing the plurality of programming instructions.

31. Referring to claim 33, Gudjonsson et al. disclose that the destination party is designated by the offeror (see column 27, line 62 through column 28, line 7).

32. Referring to claim 34, Gudjonsson et al. disclose that the offeree party accepts the offer to participate in the voice call by activating the electronic token representing the offer (see column 26, lines 7-17).

33. Referring to claim 35, Gudjonsson et al. disclose that the services for causing the voice call to be established between the designated destination party and the offeree, comprise services for causing a first voice call to be established with the offeree, for causing a second voice call to be established with the designated destination party, and for causing the first and second voice calls to be bridged to place the offeree and the designated destination party in voice communication with each other (see column 25, lines 21-42).

34. Referring to claim 36, Gudjonsson et al. disclose a computer system comprising: a storage medium (GSM phone, see column 25, line 64. Could also be a PC, see column 25, line 21 or line 43) having stored therein a plurality of programming instructions to implement a set of communication services on the computer system for generating on behalf of an offeror client, an electronic token (invitation or INVITE, see column 9, lines 3-7) representing an offer to participate in a voice call with a designated destination party, the electronic token to be

transmitted to an offeree in association with an electronic message (see column 34, lines 13-16 see column 12, lines 61-67, column 13, lines 1-11 and 28-39, and column 36, lines 32-34) and services for causing a voice call to be initiated between the destination party designated by the offeror client and the offeree immediately in response to the offeree's acceptance of the offeror client's offer by activating said electronic token (see column 26, lines 7-17); and an execution unit (GSM phone, see column 25, line 64. Could also be a PC, see column 25, line 21 or line 43) coupled to the storage medium for executing the plurality of programming instructions.

*Claim Rejections - 35 USC § 103*

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. Claims 3 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gudjonsson et al. (U.S. Patent No. 6,564,261).

37. Referring to claims 3 and 18, Gudjonsson et al. differ from claims 3 and 18 in that they fail to disclose that activating the electronic token comprises selecting the electronic token with a user input device. However, the examiner takes official notice that the use of user input devices in PC systems such as that described by Gudjonsson et al. is well known in the art and it would have been obvious to one with ordinary skill in the art at the time of the invention to use a user input device with the PC system described by Gudjonsson to activate the electronic token.

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38. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson et al. as applied to claim 7 above, and further in view of DeSimone (U.S. Patent No. 6,175,619).

39. Referring to claim 15, Gudjonsson et al. differ from claim 15 in that they fail to disclose programming instructions to implement services for receiving payment information from the offeror client in association with at least one of the first and second calls, and services for verifying the ability of the offeror client to pay an indicated amount, prior to causing the first and second voice calls to be bridged. However, providing billing information when setting up a conference call is old and well known in the art. For example, DeSimone teaches providing billing information when setting up a conference call (see column 2, lines 44-56), which has the advantage of enabling the provider of the service to collect fees for the service. One skilled in the art would have recognized the advantage of providing billing information when setting up a conference call as taught by DeSimone. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate providing billing information when setting up a conference call as taught by DeSimone into the invention of Gudjonsson et al. to achieve the advantage of enabling the provider of the service to receive payment for providing the service. Furthermore, the Examiner takes official notice that payment verification when using credit cards is old and well known in the art and has the advantage of saving the service provider money by preventing fraud. One skilled in the art would have recognized the advantage of payment verification. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate payment verification into the invention of Gudjonsson et al. in view of DeSimone to achieve the advantage of saving the service provider money.

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40. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson et al. as applied to claim 30 above, and further in view of DeSimone (U.S. Patent No. 6,175,619).

41. Referring to claim 31, Gudjonsson et al. differ from claim 31 in that they fail to disclose that the voice call is bridged only after payment verification is received by the third party from an independent party assuring that the offeror party will pay for the cost of the call. However, the Examiner takes official notice that payment verification when using credit cards is old and well known in the art and has the advantage of saving the service provider money by preventing fraud. One skilled in the art would have recognized the advantage of payment verification. Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate payment verification into the invention of Gudjonsson et al. in view of DeSimone to achieve the advantage of saving the service provider money.

*Response to Arguments*

42. Applicant's arguments filed 14 November 2003 have been fully considered but they are not persuasive.

43. Applicant has argued that, in the system of Gudjonsson et al., the offeror initiates the call, whereas in the invention of Applicant the offeree initiates the call. First, the examiner wishes to point out that the claim language does not state that the call is initiated by either party in particular, but rather that there are "services for causing a voice call to be initiated". Furthermore, the claimed invention states that an offer is sent by an offeror, and that when the offeree accepts the offer the call is initiated. Gudjonsson et al. teach that an offer is sent by an offeror, and that when the offeree accepts the offer the call is initiated. By the plain meaning of the word initiate, the system disclosed by Gudjonsson et al. has the call being initiated

immediately in response to the offeree's acceptance of the offeror client's offer because the acceptance by the offeree is what causes the call to begin. The examiner is not sure which meaning of the word Applicant is using regarding the claim, but the examiner is obligated to use the meaning of words in the claim that read most closely on the cited prior art, and to read them as broadly as reasonably possible. Although Applicant may be his own lexicographer, in this case there is no evidence that Applicant has specifically provided any special meaning for the word initiate, therefore the examiner is relying on its plain meaning.

44. Applicant has also argued that the email service of Gudjonsson et al. has nothing to do with sending an offer of a voice call to be accepted by a recipient. However, Gudjonsson et al. do disclose a means of delivering an invitation via email (see column 12, lines 61-67, column 13, lines 1-11 and 28-39, and column 36, lines 32-34).

### ***Conclusion***

45. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Michael Joseph Molinari



ALPUS H. HSU  
PRIMARY EXAMINER